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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,539	04/26/1999	ANTONIO MUNOZ-ESCALONA LAFUENTE	B-3643-61707	3400

7590

12/23/2002

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EXAMINER

PASTERCZYK, JAMES W

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 12/23/2002

26

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/299,539

Applicant(s)
Munoz-Escalona Lafuente et al.

Examiner
J. Pasterczyk

Art Unit
1755



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/11/02, 11/12/02, 11/18/02
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-18, 20, 21, 23-25, and 27-39 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 20, 38, and 39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 10-18, 21, 23-25, and 27-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-8, 10-18, 20, 21, 23-25, and 27-39 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 24
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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1. This Office action is in response to the amendments and IDS filed 10/11/02, 11/12/02 and 11/18/02 and refers to the Office action mailed 4/3/02.

2. The examiner notes that in the latest amendment, the last two claims were numbered 37 and 38. However, the claim immediately before claim 37 was already numbered 37, hence under Rule 126 claims 37 and 38 to olefin polymerization processes are renumbered 38 and 39. This numbering will be adhered to for the remainder of prosecution of this application.

3. Newly submitted claims 38 and 39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are to an olefin polymerization process.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 38 and 39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Hence claims 1-7, 10-18, 21, 23-25, and 27-37 are under consideration presently with claims 8, 20, and 38-39 withdrawn as to a nonelected invention.

4. Claims 1-7, 10-18, 21, 23-25, and 27-37 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the latest amendment, independent claims 1 and 21 are now recited as having the supported metallocene compound on

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the support being defined by formulae I, II or III. However, this reads as if the formulae as written are supposed to include the support. There is no indication in the specification that these formulae include the support; instead, what appears to be disclosed and argued is that the siloxane groups on the formulae I-III react with the support in some manner, thereby bonding the catalyst to the support material.

5. Claims 1-7, 10-18, 21, 23-25, and 27-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In independent claims 1 and 21, it is not clear whether the formulae as written actually include the support materials as the claims appear to read.

In claim 29, the recitation that the inorganic support is not functionalized appears to be in conflict with the requirement that the support be reacted with alumoxane, which would surely leave some sort of functional groups on the support, as well as being a negative limitation which appears to be contrary to *ex parte Grasselli*, 231 USPQ 393, 395, as claiming a negative limitation not disclosed.

In claims 31 and 32, it is not clear from the penultimate line of each whether "heteroatoms" encompasses carbon, since carbon is from group 14.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1-7, 10-18, 21, 23-25, and 27-37 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hidalgo Llinas as cited in and for the reasons of record given in paragraphs 6 and 8 of the previous Office action.

8. Claims 1-7, 10-18, 21, 23-25, and 27-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Antberg in view of Welborn as cited in and for the reasons of record given in paragraphs 7 and 8 of the previous Office action.

9. Applicant's arguments filed 10/11/02 and 11/18/02 have been fully considered but they are not persuasive.

With regard to the argument against the 102(a)/103(a) rejection over the Hidalgo Llinas reference, it appears to the examiner as if the material made by both the present claims and the prior art method of making it are equivalent since in both a siloxane group reacts with an oxide group to form a bridge between a metallocene and a support material. Applicants have not pointed to any comparative data which would suggest anything different.

With regard to the argument against the 103(a) rejection over the combination of Antberg and Welborn, applicants still argue that the references teach away from each other, and that there is no suggestion to combine. However, the suggestion to combine comes from Welborn which teaches that it is conventional to support a metallocene and alumoxane on a support material (p. 2, bottom), and since both references are to metallocene olefin polymerization catalysts, they are considered to be analogous art, hence it would be conventional to consider combining the two references.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Pasterczyk whose telephone number is (703) 308-3497. The examiner can normally be reached on M-F from 9 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell, can be reached on (703) 308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 for normal faxes, 872-9311 for after final faxes.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Elizabeth Wood
ELIZABETH WOOD
PRIMARY EXAMINER
AU 1755
12/21/02

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A handwritten signature in black ink, appearing to be 'JP' or 'J. Pasterczyk'.

J. Pasterczyk

12/19/02